

REMARKS

Claims 1-5, all the claims pending in the application, stand rejected.

Claim Rejections - 35 U.S.C. § 102

Claims 1-5 are rejected under 35 U.S.C. § 102(e) as being anticipated by Feibelman et al (6,499,017). This rejection is traversed for at least the following reasons.

The Examiner has repeated the rejection of claims 1-5 that appeared in the previous Office Action. In response, Applicant submitted an Amendment on March 16, 2004 that asserted the patentability of the invention without the need to amend the claims. In that Amendment, Applicant identified the essential features of the invention and compared them to the teachings of Feibelman. In particular, it was emphasized that the differences between the claimed invention and the reference lies in the functions performed by Feibelman's processor 35, as compared to the server of the present invention with reference to the flow charts of the present application.

In particular, the difference lies in the rules that are implemented by the two systems and the data that is stored in the database. For example, the present invention stores information with respect to completed transactions, particularly user identification information and data items for which a transaction process is completed. Claim 1 specifies two important steps: (1) a determination as to whether a data provision request is for a data item for which a transaction is completed, (2) if so, the data item is transmitted without performing a transaction process, and (3) if not, the transaction process is performed and the data item is transmitted. This process avoids the problem of double charging.

Applicant argued that Feibelman has no expressed teaching of any particular rules, particularly rules relevant to the claimed invention. There is no consideration of the problem of double charging nor any consideration of a solution to such problem. Feibelman et al is simply concerned with placing and satisfying orders but not with double billing. Applicant identified at least three of the functions in claim 1 that are not found in Feibelman et al including:

- (1) the functions of the determining means,
- (2) the functions of the data transmission means, and
- (3) the functions of the data retransmission means.

Thus, Applicant asserted that claim 1 cannot be anticipated by Feibelman.

In response to these arguments, the Examiner simply states that Feibelman et al teaches “a method of provisioning communication devices (i.e., a data provision device) which preferably includes transferring a customer order to an order database [note Abstract].” This assertion is general and does not reach to Applicant’s argument that the express function of three recited limitations in claims 1 and 5 is not disclosed. Applicant again respectfully submits that there is no basis for the rejection.

It is fundamental to a rejection of anticipation that:

“a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdigaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

This basic principle must be followed by the Examiner rejecting claims, as prescribed by MPEP § 2131. Moreover, where the limitations are expressed in “means plus function” format, for the claims to be anticipated, each of these functions must be literally and identically found in a single prior art reference, as required by U.S. law (see *In re Donelson* and relevant U.S.P.T.O. guidelines for means-plus-function limitations). Clearly, the Examiner has not complied with this requirement in formulating his rejection of the claims as being anticipated by Feibelman et al, as several elements of claims 1-4 are missing from the prior art reference relied on by the Examiner.

Function of the Determination Means

The “determination means” in claim 1 has a three-part function including (1) determining whether or not said data provision request is made for the data item (2) for which the transaction process is completed and (3) which is identified by the data identifying information read out by said data identifying information means.” Nothing in Feibelman teaches this three-part function of the determining means. There is no teaching or suggestion that such function should even be performed by the processor in Feibelman.

The Examiner merely comments that Feibelman teaches that “if a rule exists, then the provisioning script based upon the rule is served or transferred to the output SPD for execution to thereby provision the one or more communication devices necessary to complete the customer or request.” Reference is made to col. 6, lines 22-56 as support for this teaching.

This reference has nothing to do with the second part of the claimed function, that is, a determination relevant to whether the transaction process is completed. Indeed, Feibelman

concerns only transaction processes which are NOT completed. The Examiner's own statement of the teaching is that the text in Feibelman concerns the provision "necessary to complete the customer order or request." There is nothing disclosed with respect to determining if the transaction actually was completed. In the absence of this express function, Feibelman cannot anticipate the invention.

The disclosure at col. 6, line 22 teaches a continuous polling process in order to determine whether a transactional order has been retrieved (Step 73 Fig. 4). A determination is made as to whether a rule exist for a retrieved transaction (Step 75) and if no rule exist, the transaction fails (Step 76). And if the rule exist, the script is transferred. However, this does not teach the specifically claimed requirement of determining whether a transaction process is completed. This is fundamental to the avoidance of duplicating delivery of orders, which is the problem solved by the present invention.

The Examiner asserts that there is no consideration of whether a duplicate order and payment recited in the claims. However, the feature of determining whether a transaction process is completed is a fundamental first step to this overall solution. The claim need not state this particular solution since the combination of functions recited in the claim provide the solution this problem.

Data Transmission Means

Claim 1 further requires a data transmission means having a three-part function including (1) performing the transaction process for data provision and returning a data item in accordance with said data provision request, (2) when said determination means determines that said data

provision request is not made for the data item for which the transaction process is completed and (3) which is identified by the data identifying information read out by said data identifying information reading means” While Feibelman may contemplate returning a data item in accordance with a data provision request, there is no teaching that the request is conditional, based upon the second part of the function. Namely, when the determination means determines that the data provision request is not made for the data item for which the transaction process is completed. In other words, as taught with regard to Steps 106-108 in the present, so long as the request is not for an item that already has been provided, the order will be satisfied. This function is not disclosed in Feibelman. The Examiner has not pointed to any function in Feibelman that literally reads on this limitation of the claim. Thus, the claim cannot be anticipated.

The Examiner states that Feibelman et al’s teaching of customization of script provides flexibility of functions such as transmission protocols, with reference to col. 6, lines 5-9. Flexibility in Feibelman is not the issue. Feibelman simply does not teach the precise and literal limitations of the claim. Thus, on this basis alone the rejection should be overcome.

Data Re-transmission Means

Claim 1 also requires a data re-transmission means having a three-part function. The function includes (1) restricting said transaction process for data provision and returning the data item in accordance with said data provision request, (2) when said determination means determines that said data provision request is made for the data item for which the transaction process is completed, and (3) which is identified by the data identifying information read out by

said data identifying information reading means.” First, there is no teaching in Feibelman of restricting a transaction process for data provision. Feibelman’s sole purpose is to satisfy all requests. The only possible condition on satisfying the request is whether a transaction is retrieved, as taught at col. 6 of the patent. The use of a provisioning rule from a rule database 37 including execution of a provisioning script, is not a teaching of a restriction on the transaction as claimed. Moreover, the claim limitation is further defined by a determination that the data provision request is made for the data item for which the transaction process is completed. Again, nothing in Feibelman teaches such consideration.

The Examiner has simply avoided dealing with requirements of U.S. law for a rejection on the basis of anticipation. The Examiner argues that the Applicant’s comments with regard to a processor not performing the same function as a server completely misses the point. As already demonstrated, the functions expressly recited in the claim, which are performed by Applicant’s server, are nowhere found in Feibelman.

With respect to claim 5, which is a method claim having similar functions, the same arguments for patentability would apply.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.116
USSN: 09/866,607

Q64367

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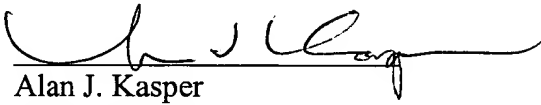
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Date: August 18, 2004